

Appl. No. : 10/534,162
Filed : May 19, 2006

REMARKS

Claims 1-35 are pending in the instant application. Applicants have amended Claim 8. Applicants maintain that the amendments to the claims add no new matter and are fully supported by the specification as originally filed.

Response to Restriction Requirement and Election

Restriction to one of the following groups was required under 35 U.S.C. 121 and 372:

- Group I Claims 1-20 and 27-31, drawn to a method for using a protein.
Group II Claims 21-26 and 32-35, drawn to a product having a polypeptide tag.

In response to the restriction requirement, Applicants elect Group II, that is, Claims 21-26 and 32-35, with traverse. The Restriction Requirement is submitted to be improper because, according to MPEP 803, there are two criteria for a proper Restriction Requirement: (A) The inventions must be independent or distinct as claimed, and (B) There would be a serious burden on the examiner if restriction is not required. Here, the members of the group are sufficiently few in number that a search and examination of the group can be made without creating a serious burden on the examiner. There would be no serious burden because the search terms would probably be overlapping.

Further, Applicants maintain that the Restriction Requirement is in conflict with Article 27 (1) PCT, which states that no national law shall require compliance with requirements relating to the form or context of the international application different from or additional to those which are provided for in the Treaty and the Regulations. Specifically, under the PCT Applicant's Guidelines, item 138, an international application which complies with the unity of invention requirement laid down in Rule 13 PCT must be accepted in all the designated and elected Offices. Here, the instant international application (WO 2004/042060) complies with the PCT unity of invention requirements, and thus should not be subject to Restriction Requirement during examination in the USPTO. Respectfully, Applicants submit that the restriction is improper, and should be withdrawn.

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Election of Species

Additionally, an election of species was required under 35 USC 121:

- (a) SEQ ID NO. 1 (Claims 5, 25, 33 and 35);
- (b) SEQ ID NO. 2 (Claims 6, 26, 33 and 35).

In response to the election of species requirement, Applicants elect species (a): SEQ ID NO. 2, that is Claims 6, 26, 33 and 35, with the understanding that the election of species is made for the purpose of examination and that upon a finding that the elected species is allowable, Applicants will be entitled to consideration of claims to additional species and the generic claim in accordance with current linking claims practice. Currently, Claims 1-5, 7-25 and 27-35 read on the elected species.

CONCLUSION


In view of the foregoing, Applicants respectfully request that this application be passed to issuance. In any point remains that can be resolved by telephone, the Examiner is invited to contact the undersigned at the below-given telephone number.

Please charge any additional fees, including any fees for additional extension of time, or credit overpayment to Deposit Account No. 11-1410.

Respectfully submitted,

KNOBBE, MARTENS, OLSON & BEAR, LLP

Dated: February 8, 2007

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